

Serial No. 10/572,820
Art Unit 2624

Docket PU030274
Customer No. 24498

Remarks

Applicants have carefully reviewed the Official action mailed 1 June 2009. To better point out and claim their invention, applicants have amended claim 1. Following this amendment, claims 1-14 remain in the application.

Double Patenting Rejection

Claim 1 stands rejected for non-statutory obvious-type double patenting over claim 1 of co-pending US Patent Application 10/575,696. This cited application identified by the examiner does not belong to the assignee of the current application and has no relationship to the claimed subject matter. Applicants believe that the examiner intended to reject claim 1 of the instant application over applicants' co-pending application Serial No. 10/575,676, filed October 12, 2004.

To overcome the rejection, attached please find a terminal disclaimer prepared in compliance with 37 C.F.R. 1.321(b) disclaiming the term of the instant application beyond that of applicants' co-pending application Serial No. 10/575,676. Upon entry of the attached terminal disclaimer, applicants request withdrawal of the double-patent rejection of claim 1.

35 U.S.C. §101 Rejection of Claims 1-14

Claims 1-14 stand rejected under 35 U.S.C. §101 as failing to fall within one of the four statutory classes of invention set forth in the statute.

As announced by the Court of Appeals for the Federal Circuit in the recently decided case *In Re Bilski*, 545 F. 3d 943, 953 (Fed Cir. 2008), the appropriate test for determining compliance with 35 U.S.C. §101 is the "machine or transformation" test as elucidated by the U.S. Supreme Court in *Benson*, 409 U.S. 70. In particular, to be eligible for a patent under 35 U.S.C. §101, a process must be tied to a particular machine or transform a particular article to a different state or thing. In this regard, the examiner

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selecting a film grain block from among a pool of previously established film grain blocks. The fact that Schlockermann et al. must await the arrival of a film grain block transmitted in the SEI message provides no motivation regarding the desirability of establishing a pool of previously established film grain blocks, and in fact teaches exactly the opposite. Thus, in the absence of any suggestion in Schlockermann et al. of previously establishing a pool of film grain blocks, this reference would teach away from applicants' step of selecting a film grain block from a pool of such previously established film grain blocks.

The Gomila et al. publication concerns the syntax of a Supplemental Enhancement Message (SEI) message that accompanies an image block encoded in accordance with the H.264/AVC compression standard. The syntax provided in Gomila et al publication describes the various parameters of a model for simulating film grain that was present in the original image. By using the parameters conveyed in the SEI message, a model of film grain can be constructed to simulate a film grain block at a decoder. Like the Schlockermann et al. publication, the Gomila et al. publication says nothing whatsoever regarding selecting a film grain block from among a pool of previously computed blocks, let alone doing so by matching the intensity of the image to the selected film grain block.

In rejecting applicants' claims in view of the Gomila et al. publication, "SEI message for Film Grain encoding: syntax and results" the examiner makes reference to Section 3.1 of the publication. This Gomila et al. publication contains no section specifically denominated as Section 3.1. Rather, Section 3 of the Gomila et al. publication describes the parameters of the SEI message syntax. As discussed on the bottom of page 3 of this Gomila et al. publication, when the id_mode equals zero, the average of each block is used to select sets of parameters that apply to all pixels in the block. When the id_mode equals 1, the sets of parameters used to generate the film grain block are selected for each pixel value.

Construing the above-reference language in Section 3 of this Gomila et al. publication as broadly as possible still would not yield any suggestion of applicants' step of selecting a film grain block from at least one previously established pool of film grain blocks whose image parameter most closely matches the image parameter of the input

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image block, as recited in applicants' claims. **The examiner should appreciate that selecting parameters for a given film grain block, as disclosed in this Gomila et al. publication does not constitute the same step of selecting a film grain block from among a pool of previously established blocks.**

The examiner's rejection of applicants' claims 1-14 over the Schlockermann et al. and Gomila et al. publications fails for several reasons. First, as discussed above, neither publication contains any disclosure of applicants' step of selecting a film grain block from at least one previously established pool of film grain blocks whose image parameter most closely matches the image parameter of the input image block, as recited in applicants' claims. Secondly, not only do the references not disclose or suggest this feature of applicants' claims, the Schlockermann et al. publication clearly teaches away from this feature. Thus, the examiner's proposed combination lacks the predictability necessary to establish a *prima facie* case of obviousness. For at least these reasons, applicants' claims 1-14 patentably distinguish over the art of record and applicants request withdrawal of the 35 U.S.C § 103(a) rejection of the claims.

The examiner's reference to the non-existent Section 3.1 in the Gomila et al. publication "SEI message for Film Grain encoding: syntax and results" appears to evidence confusion with regard to which Gomila publication the examiner actually intends to rely upon in making his rejection. Given that the Gomila et al. publication "SEI Message for Film Grain Encoding" (JVT Joint Meeting Geneva, Switzerland 23-27 May 2003) does contain a specific section 3.1, applicants presume that the examiner intended to rely of this publication rather than the other Gomila publication discussed above.

Section 3.1 on Page 3 of the Gomila et al. publication "SEI Message for Film Grain Encoding" suggests the desirability of identifying the film grain in encoded material by identifying the specific film stock used to capture the material. Identification of the film stock does not provide any suggestion of selecting a film grain block from among a pool of previously established blocks as recited in applicants' claims. Indeed, the film stock does not constitute blocks of film grain.

Assuming *arguendo* the examiner intended to rely on the Gomila et al. publication "SEI Message for Film Grain Encoding" in place of or in addition to other Gomila

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therefrom patentably distinguish over the art of record. Applicants request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-8.

Claims 9-14

The examiner's has only expressly rejected claims 1-8 in the claim rejection appearing on page 4 of the Official action. However, on pages 8 and 9 of the Official action, the examiner treats claims 9-14 as obvious, relying on the same arguments as advanced for the obviousness as claims 1-8.

Claims 9-14 depend from claim 8 and incorporate by reference all of the features of that base claim. As discussed above, the combination of the Schlockermann et al. and Gomila et al. publications do not teach applicants' claimed feature of selecting a film grain block from among a pool of previously computed blocks, let alone doing so by matching the intensity of the image to the selected film grain block, as recited in claim 8. Therefore, claims 9-14 patentably distinguish over the art of record for the same reasons as claim 8.

Information Disclosure

Applicants appreciate the examiner's citation of the co-pending applications assigned to applicant and patents of interest. In the future, applicants will cite all related applications, and applicants will furnish the examiner with copies of office actions in related cases.

Conclusion

In view of the foregoing, applicants solicit entry of this amendment and allowance of the claims. If the Examiner cannot take such action, the Examiner should contact the applicant's attorney at (609) 734-6820 to arrange a mutually convenient date and time for a telephonic interview.

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No fees are believed due with regard to this Amendment. Please charge any fee
or credit any overpayment to Deposit Account No. 07-0832.

Respectfully submitted,
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